

No. 12,540

IN THE

United States Court of Appeals
For the Ninth Circuit

JACUZZI BROS., INCORPORATED (a corporation),
Appellant and Petitioner,
vs.

BERKELEY PUMP COMPANY (a corporation), BERKELEY PUMP COMPANY (a partnership), and FRED A. CARPENTER, LANA L. CARPENTER, F. F. STADELHOFFER, ESTELLE E. STADELHOFFER, JACK L. CHAMBERS, WYNNIE T. CHAMBERS, CLEMENS W. LAUFENBERG and MARIE C. LAUFENBERG, partners associated in business under the fictitious name and style of Berkeley Pump Company,
Appellees and Respondents.

APPELLANT'S PETITION FOR A REHEARING.

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*To the Honorable William Denman, Chief Judge, and
to the Honorable Associate Judges of the United
States Court of Appeals for the Ninth Circuit:*

Petitioner, on the grounds following, petitions for rehearing of the judgment of this Court holding all the claims of petitioner's patents invalid for lack of invention.

1. FACT FINDINGS MISREAD OR ERRONEOUSLY PREMISED.

(a) The affirmance of the judgment of the Trial Court clearly shows that this Court adopted the unsupported and erroneous assumption of the Trial Court that mere submergence of gravity of the upper stage impeller was all that was necessary to make prior art multi-discharge centrifugal pump units function successfully with attached injector assemblies and produce the system combinations of petitioner's patents.

Such conclusion is based solely upon an inference gratuitously drawn, since no testimony was offered by respondents to establish that mere submergence of the impellers in the Trial Court's hypothetical assembly (Findings 27, 28 and 46, R. 86, 91) would in and of itself assure the operativeness of such assembly. The burden of proof rested squarely upon respondents to establish the operability of such a system beyond a reasonable doubt. This they failed to do to any degree.

Such assumption ignores the obvious structural differences existent in respondents' pump unit over

prior art centrifugal pump units, which differences constitute decisive factors in determining the critical and necessary favoring of the upper stage impeller over the low pressure service discharge in the division of water between them, as well as maintaining the necessary minimum volume and pressure requirements of the injector. The error of such assumption lies in misreading or disregarding those findings of the Trial Court which definitely establish the prior art centrifugal pump units to be subject to failure if low pressure service discharge is attempted in combination with an injector assembly, despite the existence of gravity separation in such pump units. In this respect, what the Trial Court actually said was:

“. . . special difficulties are presented in supplying a multi-pressure discharge from a centrifugal pump with an injector assembly attached. The injector assembly requires a certain minimum volume and pressure of water for continued operation. Therefore if too much of the water is permitted to flow from a discharge opening tapping one of the earlier impeller stages of the pump unit, insufficient water will pass through the pump to supply the injector assembly.” (R. 60, 61.)

“Multi-pressure centrifugal pumps of the type just described are old in the art, but of the specific models brought to the Court’s attention, none were designed specifically to supply water at different pressures simultaneously. The discharge openings tapping the various impeller stages were equipped with control valves with the intention that only one would be open at a time.” (R. 58, 59.)

“. . . If the control valve at this discharge opening were open too wide in relation to the volume of water being sucked into the pump, all of the water would flow out this discharge and none of it would pass on through the upper impellers to the high-pressure discharge.” (R. 59.)

Ample evidence supports these findings of the Trial Court. Thus, respondents' own expert stated as to a representative prior art multi-discharge centrifugal pump:

“A. The amount of fluid entering the second stage depends on the position of the control valve 37.” (R. 289.)

The ultimate assumption of the Trial Court that an injector assembly may be combined with the multi-discharge centrifugal pump units of the prior art, still less without invention, to duplicate petitioner's system combinations, is therefore not only unsupported by the proofs, but, on its face, is illogical as being contrary to its own findings of fact.

(b) This Court erroneously assumed with respect to system B (Claims 17 and 18 of Patent 2,424,285) that:

“No functional change was discovered.” (Opinion, p. 8.)

Such assumption is directly contrary to the proofs including the admissions of respondents in their literature. This system contributes the new and unobvious functions never before attained of providing in an assembly involving a single pump unit, either

a high-pressure low-volume discharge suitable for household requirements, or low-pressure high-volume discharge suitable for irrigation, or both types of discharge simultaneously, and of providing a dual purpose system with automatic starting at either the low or high pressure discharge lines.

For the first time in pump history has a conventional pressure tank and associated pressure switch, adjusted to one pressure, been made to control automatic starting at two widely different pressure points in the system, to-wit: the high pressure discharge point and the low pressure discharge point. This feature is difficult to understand because it is not obvious and such is evidenced by the doubts raised by the Patent Office experts during prosecution, as to how the prevailing automatic starting switch and pressure tank, adjusted to the high pressure point of the system, can automatically control starting at the low pressure point of the system. (Respondents' Exh. C, pp. 66, 67, 75, 76, 77, 88, 89, 90 thereof.)

If this Court, in concluding that no functional change was discovered in system B, had in mind the basic functions of each element in the system, then its conclusion is unsupported in law, for, in a combination, the new functions looked for are not the basic functions of the individual elements for they do not change. It is the overall functions of the combination as a distinct entity which the law considers, and such functions are measured by the new and improved results obtained by that entity as distinct from the basic function of each part.

Further, predicated on petitioner's assertion that prior art patents or publications must bear adequate teachings for the systems sought to be invalidated, this Court erroneously concludes:

“But where the accused device could be made by a competent mechanic by following suggestions . . . , such a doctrine is inapplicable.” (Opinion, p. 10.)

Such a conclusion does not constitute the test of invention, and primarily because it ignores the factor known as *conception*.

The vice of such a conclusion lies in the assumption that a mere mechanic would possess that flash of ingenuity which would disclose to him what he was to attain and how. If the conception be furnished from the patents in suit or by the flash of inspiration of another who told the mechanic what to do, then it is conceded that a mechanic could effect the combinations. But the patent law, however, does not sanction the invalidating of patents by *ex post facto* wisdom, since knowledge after the event is easy and problems once solved present no difficulty.

(c) This Court erroneously assumes that:

“Consideration of those devices already in the public domain indicates that in the patents in suit there was at highest a movement of situs of the low pressure discharge from the suction line of an old pump to the second stage or from one impeller stage to another.” (Opinion, p. 7.)

The error of this assumption is clearly and unmistakably confirmed by the fact that respondents

tried to justify shifting, on paper, the suction line discharge in their early system (Respondents' Exh. J, R. 544) to a stage of the pump unit thereof, and they were compelled to admit such a shift rendered the system *inoperative* (R. 374).

When a low pressure discharge is taken from the pump unit, the pressure and volume characteristics of the whole system are radically changed. Respondents could not produce these characteristics until they had redesigned and reconstructed their pump unit casing to assure favoring of the second stage over the low pressure discharge. They had to create a radically new pump unit.

2. ERRONEOUS RULES APPLIED.

(a) This Court has applied an erroneous rule relating to the construction of Claim 11 of petitioner's patent 2,424,285 in adopting the conclusion of the trial Court, thus:

“Claim 11 of 2,424,285, said by appellant also to be germane to System A, was found by the Trial Court to relate to a two-pump system.”
(Opinion, p. 7.)

To construe Claim 11 as relating to a two-pump system involves questions of construction which are questions of law. (*Coupe v. Royer*, 155 U.S. 565, 574-75.)

The claims of a patent are to be construed in the light of the specification. (*Carnegie Steel Co. v. Cam-*

bria Iron Company, 185 U.S. 403, 432, 79 L. Ed. 968.) This is the established rule of law and has heretofore been followed by this Court. (*Schnitzer v. Calif. Corrugated Culvert Co.*, 140 F. (2d) 275, 276.)

This Court has, in its construction of Claim 11, expanded the scope thereof to relate to two pumps, whereas the patentees in the light of their specification were using the words "high pressure pump" and "low pressure pump" to mean impeller stages of a single pump unit. While the term "pump" instead of "stage" is somewhat inept, such language was that chosen by respondents themselves to mean stages in their *Rhoda* Patent 2,315,656 (R. 536) and to cover the accused structures which involve a single pump unit with plural stages. This claim was copied verbatim from the *Rhoda* patent and awarded to the patentees of petitioner's patent as the result of an interference.

As construed in the light of the patent specification, Claim 11 is limited and restricted in meaning to a system involving a single pump unit with plural stages and, as such, the system is not exemplified in the prior art.

This Court further erroneously assumed that:

"It is our opinion, that for functional purposes in comparison of the systems of plaintiff with devices in the public domain, inclusion of two pumps or one pump is immaterial, since these are equivalent in such a system." (Opinion, p. 7.)

The Trial Court, however, found to the contrary:

“There is a significant difference between systems employing only one pump and those employing two.” (R. 73.)

The soundness of this finding of the Trial Court is established by the fact that any attempt to combine into one pump unit, the two pump units of the *Schmid* British patent (R. 595), considered by the Trial Court to negative invention of Claim 11, would necessitate eliminating the large storage tank and this would change the entire character and function of the system.

(b) This Court has further applied another rule in contravention of that uniformly recognized by the Courts and heretofore followed by this Court, in saying, after enumerating the various elements of petitioner’s system:

“These elements, when placed in aggregation, did not functionally operate differently than before.” (Opinion, p. 10.)

and

“ . . . there is no invention in placing together devices well known in the art, however novel and useful may be the results, unless a functional difference from all previous known constructions be achieved.” (Opinion, p. 10.)

If this new rule were to be followed, then there could never be invention in combinations, for the basic functions of individual components never change.

The well-recognized rule, however, is that where the conjunction or concert of elements contributes some new or improved result which exceeds the sum of its individual parts, the combination is patentable. (*Webster Loom Co. v. Higgins*, 105 U.S. 580, 591, 592, 26 L. Ed. 1177.)

This Court has heretofore followed this uniform rule. (*Wire Tie Machine Co. v. Pacific Box Corporation, Ltd.*, 102 F. (2d) 543, 552; *Bianchi v. Barili*, 168 F. (2d) 793, 798.)

The question of which rule to apply in this case involves a question of law.

Whether petitioner's system constitutes combinations or aggregations is not to be tested by the functions of the individual components isolated from the system, for, basically, a pump always functions as a pump, and an injector assembly functions as such; but rather by their cooperative functions in the system combinations.

As illustrative, petitioner's pump unit never changes its basic function of acting as a pump, but in petitioner's systems, it takes on the added function, for example, of supplying the necessary volume of water at the required high pressures to maintain the injector assembly, and therefore the system, operative, *while* discharging to service in large volume and at low pressure.

The effect of such components in the aggregate, in determining pressures and volumes of liquid at such points within the systems as to give thereto new

characteristics, cannot be brushed aside. The graphs appearing in the patent drawings of petitioner's patents visually illustrate the new pressure-volume characteristics of petitioner's systems, which characteristics are not found in the prior art systems. The uncontroverted evidence of the new and improved functions of petitioner's systems A, B and C, due to such new and different system characteristics, are summarized in petitioner's briefs and acknowledged and praised in respondents' literature.

This Court's new ruling as to construction of claims and as to the test of a combination, being so out of line and incompatible with the well-recognized law on the subjects, are likely to plague it and the patent law in cases to come.

The probability that the judgment of invalidity of petitioner's patents for lack of invention has been affirmed under misapprehension is so great that this Court should grant a rehearing on that issue.

Dated, Berkeley, California,
August 20, 1951.

Respectfully submitted,

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EDWARD BROSLER,
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The first part of the paper is devoted to a general discussion of the problem of the existence of solutions of the system of equations (1) for arbitrary values of the parameters α and β . It is shown that the system (1) has solutions for arbitrary values of the parameters α and β if and only if the condition $\alpha + \beta = 1$ is satisfied.

In the second part of the paper the problem of the stability of the solutions of the system (1) is considered. It is shown that the solutions of the system (1) are stable for arbitrary values of the parameters α and β if and only if the condition $\alpha + \beta = 1$ is satisfied.

In the third part of the paper the problem of the asymptotic behavior of the solutions of the system (1) is considered. It is shown that the solutions of the system (1) approach zero as $t \rightarrow \infty$ if and only if the condition $\alpha + \beta = 1$ is satisfied.

In the fourth part of the paper the problem of the periodicity of the solutions of the system (1) is considered. It is shown that the solutions of the system (1) are periodic if and only if the condition $\alpha + \beta = 1$ is satisfied.

In the fifth part of the paper the problem of the boundedness of the solutions of the system (1) is considered. It is shown that the solutions of the system (1) are bounded if and only if the condition $\alpha + \beta = 1$ is satisfied.

In the sixth part of the paper the problem of the convergence of the solutions of the system (1) is considered. It is shown that the solutions of the system (1) converge to zero if and only if the condition $\alpha + \beta = 1$ is satisfied.

In the seventh part of the paper the problem of the divergence of the solutions of the system (1) is considered. It is shown that the solutions of the system (1) diverge to infinity if and only if the condition $\alpha + \beta = 1$ is satisfied.

In the eighth part of the paper the problem of the oscillation of the solutions of the system (1) is considered. It is shown that the solutions of the system (1) oscillate if and only if the condition $\alpha + \beta = 1$ is satisfied.

In the ninth part of the paper the problem of the non-oscillation of the solutions of the system (1) is considered. It is shown that the solutions of the system (1) do not oscillate if and only if the condition $\alpha + \beta = 1$ is satisfied.

In the tenth part of the paper the problem of the stability of the solutions of the system (1) with respect to the initial conditions is considered. It is shown that the solutions of the system (1) are stable with respect to the initial conditions if and only if the condition $\alpha + \beta = 1$ is satisfied.

In the eleventh part of the paper the problem of the stability of the solutions of the system (1) with respect to the parameters is considered. It is shown that the solutions of the system (1) are stable with respect to the parameters if and only if the condition $\alpha + \beta = 1$ is satisfied.

In the twelfth part of the paper the problem of the stability of the solutions of the system (1) with respect to the structure is considered. It is shown that the solutions of the system (1) are stable with respect to the structure if and only if the condition $\alpha + \beta = 1$ is satisfied.

In the thirteenth part of the paper the problem of the stability of the solutions of the system (1) with respect to the boundary conditions is considered. It is shown that the solutions of the system (1) are stable with respect to the boundary conditions if and only if the condition $\alpha + \beta = 1$ is satisfied.

In the fourteenth part of the paper the problem of the stability of the solutions of the system (1) with respect to the control is considered. It is shown that the solutions of the system (1) are stable with respect to the control if and only if the condition $\alpha + \beta = 1$ is satisfied.

In the fifteenth part of the paper the problem of the stability of the solutions of the system (1) with respect to the disturbance is considered. It is shown that the solutions of the system (1) are stable with respect to the disturbance if and only if the condition $\alpha + \beta = 1$ is satisfied.

In the sixteenth part of the paper the problem of the stability of the solutions of the system (1) with respect to the noise is considered. It is shown that the solutions of the system (1) are stable with respect to the noise if and only if the condition $\alpha + \beta = 1$ is satisfied.

In the seventeenth part of the paper the problem of the stability of the solutions of the system (1) with respect to the uncertainty is considered. It is shown that the solutions of the system (1) are stable with respect to the uncertainty if and only if the condition $\alpha + \beta = 1$ is satisfied.

In the eighteenth part of the paper the problem of the stability of the solutions of the system (1) with respect to the perturbation is considered. It is shown that the solutions of the system (1) are stable with respect to the perturbation if and only if the condition $\alpha + \beta = 1$ is satisfied.

In the nineteenth part of the paper the problem of the stability of the solutions of the system (1) with respect to the error is considered. It is shown that the solutions of the system (1) are stable with respect to the error if and only if the condition $\alpha + \beta = 1$ is satisfied.

In the twentieth part of the paper the problem of the stability of the solutions of the system (1) with respect to the disturbance is considered. It is shown that the solutions of the system (1) are stable with respect to the disturbance if and only if the condition $\alpha + \beta = 1$ is satisfied.

CERTIFICATE OF COUNSEL.

The foregoing Petition for Rehearing is believed to be meritorious and is presented in good faith and not for delay.

Dated, Berkeley, California,
August 20, 1951.

CHARLES O. BRUCE,
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